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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/893,905

06/29/2001

Akiko Naruse

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4929

22852

7590

06/30/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

HASHEM, LISA

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,905

Applicant(s)

NARUSE ET AL.

Examiner

Lisa Hashem

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 8, and 15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,442,263 by Beaton et al, hereinafter Beaton.

Regarding claim 1, Beaton discloses a communication terminal (Fig. 2, 210) adapted to be connected to a network which provides a service function for notifying of a message that contains a caller phone number and a caller name (col. 6, lines 43-49), the communication terminal comprising: a phone book for storing user identification information containing a user phone number and a user name to be associated with the user phone number for each communication party user (col. 6, lines 25-28; col. 6, lines 50-67; Fig. 6); message receiving means for receiving the caller phone number and the caller name in the message included in an incoming call signal from the network; display mode setting means for setting either a first display mode for displaying only the received message received by said message receiving means (Fig. 16, 1635) or a second display mode for displaying only the user identification information stored in the phone book (Fig. 16, 1630); determining means for determining whether the first display mode or second display mode is set by said display mode setting means; comparing means for comparing the received caller phone number with each stored user phone

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number stored in the phone book; and display means for displaying the received caller name and the stored user name corresponding to a stored user phone number that coincides with the received caller phone number according to the determination result of the determining means, wherein said display means displays only the message received by said message receiving means when the first display mode is set (Fig. 16, 1635) or when the received caller phone number does not coincide with one of the user phone numbers stored in the phone book, and displays only the stored user identification information including one of the stored phone numbers when the received caller phone number coincides with one of the user phone numbers stored in the phone book (Fig. 16, 1630) (col. 8, lines 26-53; col. 10, lines 23-53; Fig. 16).

Regarding claim 8, Beaton discloses a radio communication terminal (Fig. 2, 210) comprising: a phone book for storing user identification information containing a user phone number and a user name to be associated with the user phone number for each communication party user (col. 6, lines 25-28; col. 6, lines 50-67; Fig. 6); receiving means for receiving an incoming call signal including a caller phone number and a caller name; display mode setting means for setting either a first display mode for displaying only the message received by said message receiving means (Fig. 16, 1635) or a second display mode for displaying only the user identification information stored in the phone book (Fig. 16, 1630); determining means for determining whether the first display mode or second display mode is set by said display mode setting means; comparing means for comparing the received caller phone number with each stored user phone number stored in the phone book; and display means for displaying the received caller name and the stored user means corresponding to a stored user phone number that coincides with the received caller phone number according to the determination result of the

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determining means, wherein said display means displays only the message received by said receiving means when the first display mode is set (Fig. 16, 1635) or when the received caller phone number does not coincide with one of the user phone numbers stored in the phone book, and displays only the stored user identification information including one of the stored phone numbers when the received caller phone number coincides with one of the user phone numbers stored in the phone book (Fig. 16, 1630) (col. 8, lines 26-53; col. 10, lines 23-53; Fig. 16).

Regarding claim 15, Beaton discloses a radio communication terminal (Fig. 2, 210) comprising: a memory for storing a phone number and a user name associated with the phone number (col. 6, lines 25-28; col. 6, lines 50-67; Fig. 6); means for obtaining a caller phone number and a caller name from an incoming call (col. 6, lines 43-49); means for setting either a first display mode for displaying the obtained caller name (Fig. 16, 1635) or a second display mode for displaying the stored user name preferentially (Fig. 16, 1630); means for comparing the obtained caller phone number with the stored user phone number; and means for displaying the obtained caller name when the first display mode is set (Fig. 16, 1635) or when the second display mode is set (Fig. 16, 1630) and the obtained caller phone number does not coincide with the stored phone number, and for displaying the stored user name when the second display mode is set and the obtained caller phone number coincides with the stored phone number (col. 8, lines 26-53; col. 10, lines 23-53; Fig. 16).

Response to Arguments

3. Intended Use Limitations: A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art – if the prior art has the capability to so perform (see MPEP 2114 and *Ex parte Masham*, 2 USPQ2d

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1647 (1987). Thus the claim limitations in the examined claims above that employ phrases of type: "FOR" doing something, e.g. 'display mode setting means for', 'determining means for', etc. These are typical of claim limitations, which may not distinguish over the prior art. The references noted above have the structure and functions of performing the claimed limitations.

4. Applicant's arguments, see RCE, filed 5-9-2005, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Please see all rejections above.

5. Accordingly, this action is **NON-FINAL**.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent Application Publication No. US 2003/0147518 by Albal et al teach a system and method of identifying a caller is provided. A determination is made as to whether a caller's number is associated with a stored number in a called party's address book. A name and location associated with the stored number is delivered by the communication node to provide the name and location of the caller to the subscriber

7. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 872-9306 (for formal communications intended for entry)

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Or call:

(571) 272-2600 (for customer service assistance)

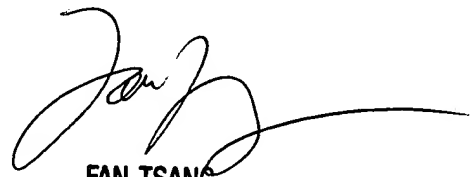
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH
lh

June 21, 2005



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600